

REMARKS

Claims 24 and 30-34 are currently pending in the present Application. Claim 35 has been added by the present Amendment. No claims have been cancelled or amended by this Amendment. Thus, claims 24 and 30-35 are presently at issue.

Rejections Under 35 U.S.C. § 103(a)

In paragraph 3 of the Office Action, the Examiner rejected claims 24 and 30-34 under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 5,806,900 to Bratcher *et al.* ("Bratcher"), in view of U.S. Patent No. 6,575,681 to Kojima *et al.* ("Kojima"). Applicant traverses the Examiner's rejections and respectfully requests reconsideration and withdrawal of the same.

It is the burden of the Patent and Trademark Office to establish a *prima facie* case of obviousness when rejecting claims under 35 U.S.C. § 103. *In re Reuter*, 210 U.S.P.Q.2d 249 (CCPA 1981). To establish a *prima facie* case of obviousness, three basic criteria must be met: first, there must be some suggestion, incentive or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings; second, there must be a reasonable expectation of success; and third, the prior art references must teach or suggest all the claim limitations. *See In re Geiger*, 815 F.2d 686, 688 (Fed. Cir. 1988). Furthermore, the teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, not in the Applicant's disclosure. *In re Vaeck*, 947 F.2d 488, 20 U.S.P.Q.2d 1438 (Fed. Cir. 1991).

Applicant submits that Bratcher and Kojima are not properly combinable to form a *prima facie* case of obviousness with respect to claims 24 and 30-34. First, Kojima deals with a completely separate and non-analogous art. A prior art reference is analogous if the reference is in the field of applicant's endeavor or, if not, the reference is reasonably pertinent to the particular problem with which the invention was concerned. *In re Oetiker*, 977 F.2d 1443, 1445 (Fed. Cir. 1992). One relevant problem solved by the present invention deals with insertion of a moveable window stop into an elongated opening in a window frame having a variable

thickness. Kojima deals with insertion of a stationary clip for holding a hose or wire harness into a circular hole in a panel for an automobile. There is no suggestion or disclosure in Kojima to use the disclosed clip in connection with a window assembly, not even an automobile window assembly. One skilled in the art of windows and window stops would not look to automobile panels and clips therefor to solve such a problem. Further, Bratcher provides no suggestion of any need to modify the clips (34) to adapt to window frames having different thicknesses. Thus, the Examiner has engaged in improper hindsight analysis by using Applicant's claim as a template, rather than focusing on the knowledge and motivation available to those skilled in the art at the time of invention. *See In re Fine*, 837 F.2d 1071, 1075 (Fed. Cir. 1988) ("one cannot use hindsight reconstruction to pick and choose among isolated disclosures in the prior art to deprecate the claimed invention").

Second, Kojima does not disclose even one advantage to configuring the locking parts (41) in any type of angled or inclined arrangement with respect to the flange (20). Kojima does disclose having a stepped configuration of the locking parts (41), and, in the embodiment shown in FIGS. 6-7C, the locking parts (41) appear to be angled downward. However, Kojima never discusses any advantage of arranging the locking parts (41) and the flange (20) in any particular inclined arrangement. Thus, even if one skilled in the art would be motivated to look outside the relevant art to Kojima to develop a window stop for insertion into a frame of varying thickness, Kojima provides no motivation or suggestion to utilize a ridge or surface that is inclined with respect to the lip thereof.

Third, the features of the resin clip of Kojima would require significant modification to be incorporated into a window stop. The resin clip of Kojima is configured for insertion into a circular opening (See Kojima, FIG. 1), not an elongated opening, into which a window stop is typically inserted. (See Bratcher, FIG. 1). Additionally, the flange (20) of Kojima is inclined downward, in contrast to the lip of a window stop, which is typically parallel to the surface on which it rests. (See Bratcher, FIGS. 7-8). Thus, because Kojima provides no motivation or suggestion to arrange the flange (20) and the stepped locking parts (41) in any particular inclined arrangement to each other, the Examiner can only speculate what type of window stop would result from the combination of Bratcher and Kojima. In particular, because the locking parts (41) of Kojima are inclined similarly to the flange (20), it is just as likely that such a combination

would yield an engagement surface having a ridge or surface that is parallel to the lip. Thus, the Examiner has not presented a *prima facie* case of obviousness with respect to claims 24 and 30-34.

Additionally, Applicants submit that the proposed combination of Bratcher and Kojima does not disclose, teach, or suggest all the elements of claims 30-34. Claim 30 includes, among other elements, “the tab having a planar engagement surface distal from the base portion, the planar engagement surface being spaced from the lip and inclined with respect to the lip.” As shown in FIG. 15 of the present Application, the surface (245) is disclosed as an inclined planar engagement surface. The Examiner acknowledges, in paragraph 3 of the Office Action, and in the previous Office Action, that Bratcher does not disclose, teach, or suggest this element of claim 30. Applicant submits that Kojima also does not disclose, teach, or suggest this element of claim 30.

Kojima discloses a resin clip (10) designed to be fitted into an attachment hole in a panel for an automobile. The resin clip (10) having a skirt-like flange (20), a pillar (30) depending from the flange (20), and a pair of elastic legs (40) extending from the bottom of the pillar (30) back toward the flange (20), each leg (40) having several stepped locking parts (41a, 41b, 41c) at the tip thereof. (Kojima, Col. 3, Lines 52-59; Col. 4, Lines 51-53). Kojima does not disclose a tab having a “planar engagement surface.” Rather, the resin clip (10) of Kojima has a stepped engagement surface containing several stepped locking parts (41), rather than a planar engagement surface. Furthermore, Kojima does not suggest modifying the stepped locking parts to a planar engagement surface. Thus, neither Bratcher nor Kojima discloses, teaches, or suggests this element of claim 30, and the Examiner has not made a *prima facie* case of obviousness with respect to claim 30.

Claims 31-33 depend from claim 30 and contain all the elements of claim 30. Thus, for the reasons stated above with respect to claim 30, the Examiner has not made a *prima facie* case of obviousness with respect to claims 31-33.

Claim 34 includes, among other elements, “each tab having a smooth engagement surface distal from its base portion, each smooth engagement surface being spaced from the lip and inclined with respect to the lip.” The Examiner acknowledges, in paragraph 3 of the Office Action, and in the previous Office Action, that Bratcher does not disclose, teach, or suggest this

element of claim 34. Applicant submits that Kojima also does not disclose, teach, or suggest this element of claim 34.

Kojima discloses a resin clip (10) designed to be fitted into an attachment hole in a panel for an automobile. The resin clip (10) having a skirt-like flange (20), a pillar (30) depending from the flange (20), and a pair of elastic legs (40) extending from the bottom of the pillar (30) back toward the flange (20), each leg (40) having several stepped locking parts (41a, 41b, 41c) at the tip thereof. (Kojima, Col. 3, Lines 52-59; Col. 4, Lines 51-53). Kojima does not disclose a tab having a “smooth engagement surface.” Rather, the resin clip (10) of Kojima has a stepped engagement surface containing several stepped locking parts (41), rather than a smooth engagement surface. Furthermore, Kojima does not suggest modifying the stepped locking parts to a smooth engagement surface. Thus, neither Bratcher nor Kojima discloses, teaches, or suggests this element of claim 34, and the Examiner has not made a *prima facie* case of obviousness with respect to claim 34.

New Claim 35

Claim 35 has been added by the present Amendment, and contains all the elements of claim 30. Thus, for the reasons stated above with respect to claim 30, Applicants submit that Claim 35 is patentable over the cited prior art. Additionally, claim 35 includes the element, “the planar engagement surface extending from an inner edge of the tab proximal to the housing to an outer edge of the tab distal from the housing.” This feature is shown in FIG. 15 of the Application and described at Page 18, Lines 12-18. Applicants submit that this additional element of claim 35 is also not disclosed by the cited prior art, and thus, claim 35 is patentable.

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Reply to Office Action of January 20, 2006


CONCLUSION

Applicants submit the application is in condition for allowance. Accordingly, Applicants respectfully request reconsideration and allowance of claims 24 and 30-34, as well as allowance of new claim 35. The Examiner is also requested to contact the undersigned if the Examiner has any questions concerning this Reply or if it will expedite the progress of this application.

Respectfully submitted,

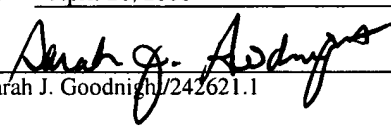
Dated: April 20, 2006

By: _____


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CERTIFICATE OF MAILING (37 C.F.R. § 1.8a)

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on April 20, 2006



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